

REMARKS

Prior to this response, Claims 1-15 were pending in this application, with Claims 14 and 15 withdrawn from consideration. No claims are added or canceled. Hence, Claims 1-15 are presently pending in this application, with Claims 1-13 under examination and Claims 14 and 15 withdrawn from consideration.

Claims 1, 2, 8 and 11 are amended herein to place the application in condition for allowance. No new matter is introduced in the application by way of these claim amendments, and no further search should be required. Hence, entry of this amendment is most earnestly solicited.

OBJECTIONS

In the Specification

The Office Action objected to the specification on the premise that, in the Abstract, “legal phraseology often used in patent claims ... should be avoided.” Specifically, the Office Action objects to the Abstract because it contained the term “comprises”. A substitute Abstract is attached hereto, which replaces “comprises” with “includes.” Therefore, the objection to the Abstract is now moot.

REJECTION BASED ON PRIOR ART

Rejection under 35 U.S.C. §103(a)

(I) Claims 1-4, 6-8 and 12 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Lee (“*Lee*”; U.S. Patent No. 4,872,401) in view of Crawley (“*Crawley*”; U.S. Patent Application Publication No. 2002/0025086).

Claim 1

The Office Action takes the position that the term “distal end” is broad and interprets the term to include “some of the sidewall” and that the “‘end’ is the part that is near the bottom.”

Claim 1 is amended to replace the term “distal end” with “bottom” in relation to the outer sheath and the inner bag. Hence, it is clear that the second magnets are between the bottom of the inner bag and the bottom of the outer sheath. This configuration is described in the specification at, for example, paragraph [0040]. Paragraph [0040] discloses that the bottom or distal portion of tool 100 is constructed of magnet 005, optional shield 006 and optional magnet housing 007, and that this distal portion of tool 100 is fastened or otherwise coupled to the inside bottom or distal end of the outer sheath 004. Thus, no new matter is introduced into the application by way of this claim amendment, and no further search should be required.

Lee does not disclose or suggest use of one or more magnets positioned between the bottom of a removable inner bag and the bottom of the outer sheath. By contrast, *Lee* discloses magnetic pieces 20 that are clearly annular (col. 2, lines 4-26; Fig. 1) and used to produce a magnetic field to affect the properties of a substance held therein (e.g., col. 1, lines 14-31). *Lee* does not disclose, suggest or motivate an apparatus for containing debris, which uses a magnet positioned as recited in Claim 1, to help contain and secure within an inner bag any magnetic debris that may enter the inner bag. Therefore, Claim 1 is patentable over *Lee* and *Crawley* and withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Lee* and *Crawley*, is requested.

Claims 2-4, 6-8 and 12

The remaining claims under this rejection, Claims 2-4, 6-8 and 12, depend directly or indirectly from Claim 1. Therefore, Claims 2-4, 6-8 and 12 are patentable over *Lee* and *Crawley* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claims 2-4, 6-8 and 12 under 35 U.S.C. §103, based on based on *Lee* and *Crawley*, is requested.

(II) Claim 11 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Lee* in view of *Crawley*, further in view of previous examiner's official notice that was not traversed and, therefore, is being treated as admitted prior art.

Claim 11

Claim 11 depends from Claim 1 and is patentable over *Lee* and *Crawley* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claim 11 under 35 U.S.C. §103, based on *Lee* and *Crawley* and examiner's official notice, is requested.

(III) Claims 1-3, 6-8 and 10-13 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Lee* in view of previous examiner's official notice that was not traversed and, therefore, is being treated as admitted prior art.

Claim 1

As noted above, *Lee* does not disclose or suggest use of one or more magnets positioned between the bottom of a removable inner bag and the bottom of the outer sheath. Therefore, Claim 1 is patentable over *Lee* and examiner's official notice and withdrawal of this rejection of Claim 1 under 35 U.S.C. §103 is requested.

Claims 2, 3, 6-8 and 10-13

The remaining claims under this rejection, Claims 2, 3, 6-8 and 10-13, depend directly or indirectly from Claim 1. Therefore, Claims 2, 3, 6-8 and 10-13 are patentable over *Lee* and examiner's official notice for at least the foregoing reasons discussed in reference to Claim 1 and withdrawal of this rejection of Claims 2, 3, 6-8 and 10-13 under 35 U.S.C. §103 is requested.

CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims currently under consideration (1-13) present patentable subject matter over the references of record, and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

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John D. Henkhaus
John D. Henkhaus
Reg. No. 42,656

2055 Gateway Place, Suite 550
San Jose, CA 95110
(408) 414-1080
Facsimile: (408) 414-1076

Attachment: Substitute Abstract

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